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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/556,227

11/09/2005

Laurent David

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11/21/2007

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EXAMINER

MORRIS, PATRICIA L

ART UNIT

PAPER NUMBER

1625

MAIL DATE

DELIVERY MODE

11/21/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/556,227	Applicant(s) DAVID ET AL.	
	Examiner Patricia L. Morris	Art Unit 1625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 November 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12-22 is/are pending in the application.
- 4a) Of the above claim(s) 18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed:
- 6) ☒ Claim(s) 12, 13, 16, 20 and 22 is/are rejected.
- 7) ☒ Claim(s) 14, 15, 17, 19 and 21 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Claims 12-17 and 20-22 are under consideration in this application.

Claim 18 is held withdrawn from consideration as being drawn to nonelected subject matter 37 CFR 1.142(b).

Election/Restrictions

Applicant's election without traverse of Group I, the species 4-(2-ethyl-phenylamino)-2-(4-fluorophenyl)-1H-pyrrolo[2,3-b]pyridine-5-carboxylic acid amide in the reply filed on November 6, 2007 is acknowledged.

Claim 20 has been examined to the extent readable on the elected method of use, *i.e.*, the treatment of asthma, exclusively.

This application has been examined to the extent readable on the elected compounds wherein R² represents nonheterocyclic groups and Ar, R¹, R³, R⁴, n as set forth in claim 12, exclusively.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 12, 13, 16, 20 and 22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The definition of Ar in claim 12 is indefinite because it is unclear whether Ar is optionally substituted by the recited substituents or Ar also represents C₁-C₈alkyl-NR³R⁴ etc. The group C₁-C₈ represents a terminal group and not a linking alkylene group attached to the NH.

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The plural 's' on "salts" makes claim 12 read on mixtures rather than specific compounds.

Regarding claims 13 and 16, the phrases "in particular" and "more preferably" render the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention.

Claim 20 fails to recite an effective amount of active ingredient. A mere trace may prove inoperable.

Claim 22 lacks antecedent basis for the variable R^1 because claim 12 does not define R^1 as a protected derivative. Further, the expressions protected derivative and leaving group are unclear to its meaning.

Claim 22 fails to clearly claim the process because it fails to recite the reaction conditions, *i.e.*, reactants, reagents, solvents, etc. The term "converting" renders the claims indefinite and based on an inadequate or insufficient disclosure by placing no definite limits or boundaries in the claim. "Converting" does not signify that a reaction has taken place and should accordingly be changed to reacting. Salt formation is an obvious process under 35 USC 103. What further compounds of formula (I) are intended? Claim 12 does not define further compounds of formula (I).

The claims measure the invention. *United Carbon Co. V. Binney & Smith Co.*, 55 USPQ 381 at 384, col. 1, end of 1st paragraph, Supreme Court of the United States (1942).

The C.C.P.A. in 1978 held "that invention is the subject matter defined by the claims submitted by the applicant. We have consistently held that no applicant should have limitations of the specification read into a claim where no express statement of the limitation is included in the claim": *In re Priest*, 199 USPQ 11, at 15.

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Allowable Subject Matter

Claim 12 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and if rewritten directed solely to the subject matter indicated as being examinable, supra. A claim so limited would appear allowable.

Claims 13, 16, 20 and 22 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims and if rewritten directed solely to the elected compounds and method of use.

Claims 14, 15, 17, 19 and 21 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims and if rewritten directed solely to the elected compounds.

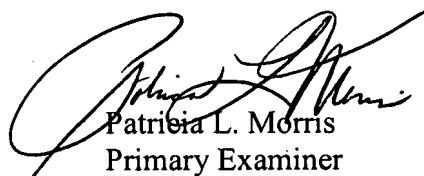
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patricia L. Morris whose telephone number is (571) 272-0688. The examiner can normally be reached on Mondays through Fridays.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Patricia L. Morris
Primary Examiner
Art Unit 1625

plm
November 19, 2007